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Technology Center 2100 Paper No. 28

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In re Application of: Howard)
Application No. 08/920,433)
Attorney Docket No. 43-97-001)
Filed: August 29, 1997)
For: METHOD AND SYSTEM OF)
PROVIDING ACCESS PRIVILEGES TO)
RECORDS OF MEMBERS OF A)
COMMUNITY)

This is in response to the petition filed on July 29, 2003, under 37 CFR §1.181, to resolve certain issues prior to appeal, including review of the denial of entry of the appeal brief filed July 24, 2002.

A petition under this section must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. The petition filed July 29, 2003 includes elements (1) and (2) above.

The petition is **GRANTED**, to the extent indicated below.

RECENT PROSECUTION HISTORY

On February 27, 2002, the Examiner issue a non-final Office action, rejection all pending claims (1-7 and 9-21) under 35 U.S.C. 102, sections (b) and (e).

On May 24, 2002, a notice of appeal was filed.

On July 24, 2002, an appeal brief was filed by Appellant.

On May 29, 2003, a notification of Non-Compliance with 37 CFR §1.192(c) was mailed to Appellant, indicating that Issue 1, identified in the appeal brief of July 24, 2002, was not an appealable issue, but rather a petitionable one.

On July 9, 2003 an interview summary was mailed to Appellant indicating the substance of the interview held on June 27, 2003.

On July 29, 2003, the instant petition under 37 CFR §1.181 was filed.

RELIEF REQUESTED

The instant petition under 37 CFR 1.181 requests the following relief: to (1) vacate the grounds of rejection because the Examiner has failed to satisfy the requirements of 35 U.S.C. §132 and 37 CFR §1.104 regarding the rejections of claims 1-7 and 9-21 under 35 U.S.C. §102 (b) and (e); or, in the alternative, (2) declare that Appellant's case is ripe for appeal and that Appellants' appeal brief is compliant under 37 CFR §1.192(c) i.e. that the Notification of Non-Compliance, mailed May 29, 2003 was improper.

BASIS OF OPINION

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to critical phrases.

MPEP § 1201 states in-part:

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. *Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.*

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter.

§ 1.192 Appellant's brief.

(c) *The brief shall contain the following items under appropriate headings and in the order indicated below* unless the brief is filed by an applicant who is not represented by a registered practitioner:

- (1) **Real party in interest.** A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.
- (2) **Related appeals and interferences.** A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.
- (3) **Status of claims.** A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed.
- (4) **Status of amendments.** A statement of the status of any amendment filed subsequent to final rejection.
- (5) **Summary of invention.** A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.
- (6) **Issues.** A concise statement of the issues presented for review.
- (7) **Grouping of claims.** For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing

out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) **Argument.** The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(9) **Appendix.** An appendix containing a copy of the claims involved in the appeal.

With respect to the requested relief to vacate the grounds of rejection (relief item (1) above), set forth in the non-final Office action mailed February 27, 2002 of claims 1-7 and 9-21 under 35 U.S.C. §102 (b) and (e), because "the Examiner has failed to satisfy the requirements of 35 U.S.C. §132 and 37 CFR §1.104 regarding the rejections", a discussion follows. The argument with respect to the issue of whether the Examiner has met his burden of proof of setting forth a *prima facie* case of inherency under 35 USC §102 (b) and (e), although couched in the language of the instant petition, is a question raised that relates to the merits (MPEP 1201) i.e. the propriety of the rejection of the claims of the instant application. Therefore, this issue is subject to appeal, and is properly decided by the Board of Appeals. The Office regrets that appellants have been misdirected on this point.

As such, the issue with respect to the propriety of the rejection (of claims) set forth by Appellant (issue 1 in the appeal brief), will be merged with the issue with respect to the rejection of the claims under the particular references set forth under 35 U.S.C. §102 (b) and (e), by the Examiner (issue 2 in the appeal brief).

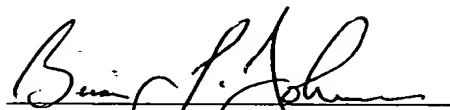
With respect to the requested relief that Appellant's case is ripe for appeal (relief item (2) above), the petitioners argue the declaration of a non-compliant appeal brief by the examiner was improper. As set forth above and upon review of the appeal brief filed July 24, 2002, it has been determined that each item, as identified under 37 CFR §1.192(c), is included in the brief. Thus, since the appeal brief filed July 24, 2002 includes each of the items, under the appropriate headings, and since the issues therein are deemed appropriate appealable matter, the brief is determined to be complete and proper.

DECISION

The petition is **GRANTED**, to the extent indicated above. Therefore, the notice of non-compliance is hereby withdrawn. Appellant's appeal brief is proper and has been entered. Accordingly, the alternate relief requested by Petitioner i.e. vacating the grounds of rejection of claims 1-7 and 9-21 under 35 U.S.C. §102 (b) and (e), because the Examiner has failed to satisfy the requirements of 35 U.S.C. §132 and 37 CFR §1.104 regarding the rejections, is *moot* in view of the decision set forth above.

The application is being forwarded to the Examiner for appropriate action.

Any inquiries related to this decision may be directed to the undersigned at (703) 308-0885.

A handwritten signature in black ink, appearing to read "Brian L. Johnson", is written over a horizontal line.

Brian L. Johnson, SPRE
Technology Center 2100
Computer Architecture, Software, and Information Security

BLJ: 9/30/04